

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT:	Terrence SICK et al.	GROUP:	3693
APPLICATION:	09/965,071	EXAMINER:	S. Chandler
FILED:	September 27, 2001	CONFIRMATION:	2718
FOR:	COMPUTER-BASED SYSTEM AND METHOD FOR SEARCHING AND SCREENING FINANCIAL SECURITIES AND RELEVANT INTELLECTUAL PROPERTY		

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

LETTER ACCOMPANYING REPLY BRIEF

In response to the Examiner's Answer (dated February 28, 2008) and Supplemental Examiner's Answer dated March 21, 2008, Appellants submit herewith a Reply Brief. No oral hearing is requested, and Appellants respectfully request that the Board render a decision based upon the parties written submissions, including Appellants' Appeal Brief and the enclosed Reply Brief.

Respectfully submitted,



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APPELLANTS' REPLY BRIEF

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1. STATUS OF CLAIMS:

Claims 1 - 17 remain rejected in the application. The rejections of claims 1 -17 are appealed herein.

2. GROUND OF REJECTION TO BE REVIEWED ON APPEAL:

The grounds for rejection remain as set forth in the Appeal Brief, and in the Final Office Action of May 4, 2007.

Claims 3-6, 8, 9, 11-13 and 15-17 remain rejected under 35 USC §102(e) as being anticipated by Rivette et al., US Patent 5,991,751 (hereinafter "Rivette").

Claim 10 remains rejected under 35 USC §103(a) as being unpatentable over Rivette, with the Examiner taking Official Notice.

Claims 1, 2, 7 and 14 remain rejected under 35 USC §103(a) as being unpatentable over Rivette in view of Black et al., US Patent 6,012,042 (hereinafter "Black").

3. ARGUMENT:

Further to Appellants arguments submitted in the Appeal Brief, the following arguments are responsive to the Examiner's Answer and the Board is respectfully requested to consider such arguments in combination with the previously-submitted Appeal Brief. Moreover, to the extent the following arguments set forth specific arguments in traversal of rejections for both independent and dependent claims Appellants respectfully request that the Board, as previously requested in the Appeal Brief, consider the separately argued dependent claims based upon their own merits.

Several questions were presented in the Appeal Brief and are repeated herein for convenience:

First, whether claims 3-6, 8, 9, 11-13 and 15-17 were properly rejected under 35 USC §102(e) as being anticipated by Rivette, including whether the rejection properly establishes *anticipation* of each and every element recited in the rejected claims.

Second, whether Claim 10 was properly rejected under 35 USC §103(a) as being unpatentable over Rivette, with Official Notice, including

(a) whether the rejection properly establishes *prima facie* obviousness and provided some articulated reasoning and some rational underpinning to support the legal conclusion of obviousness;

(b) whether the rejection under 35 USC §103(a) improperly relies upon information that has not been established as having been available prior to Appellants' application; and

(c) whether the rejection under 35 USC §103(a) omits elements recited in the rejected claims.

Third, whether claims 1, 2, 7 and 14 were properly rejected under 35 USC §103(a) as being unpatentable over Rivette in view of Black, including

(a) whether the rejection properly establishes *prima facie* obviousness and provided some articulated reasoning and some rational underpinning to support the legal conclusion of obviousness; and

(b) whether the rejection under 35 USC §103(a) omits elements recited in the rejected claims.

Appellants respectfully submit that this invention is unique and has extensive application and utility.

First Question - Rejection Under 35 U.S.C. §102

As Appellants previously noted, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As further set forth in MPEP §2131, to anticipate a claim, a reference must teach every element recited in the claim. Moreover, "...if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

As the following discussion will illustrate the Examiner failed to establish, as the basis for the rejection, where each recited limitation was taught by the reference relied upon.

(I) Were claims 3-6, 8, 9, 11-13 and 15-17 properly rejected under 35 USC §102(e) as being anticipated by Rivette?

With respect to **independent claims 3 and 11**, Rivette is directed to a system, and method, and computer program product for patent-centric and group-oriented data processing, and discloses a system for evaluating the value of a corporation's patent portfolio. The context for the disclosure set forth in Rivette is found, for example, at col. 2, line 61 – col. 3, line 9, where Rivette sets the background of its disclosure relative to a corporation assessing its patent or patent business strategy.

"For the most part, existing patent-related tools can process only the information contained in patents. (It is noted, however, that the SmartPatent Workbench has functions to annotate patents with any information, whether or not patent related, and has additional functions to search within annotations.) These tools do not have functions for

correlating, analyzing, and otherwise processing patent-related information with non-patent related information, including but not limited to corporate operational data, financial information, production information, human resources information, and other types of corporate information. Such non-patent information is critically important when evaluating the full strategic and tactical value and applicability of any given patent, or developing a corporate patent business strategy for gaining competitive advantage and increasing shareholder value based on patents." (*Rivette 5,991,571; col. 2, line 61 – col. 3, line 9*)

In the "Overview of the Invention" starting at col. 9 (bottom), Rivette describes "evaluating the value of the corporation's patent portfolio (represented as part of the patent information 204)" (col. 10, lines 50-52). Appellants continue to maintain that Rivette discloses a system that processes patent information for a single corporation (e.g., "a corporate entity" col. 3, line 63; "the corporation" col. 4, line 8).

Conversely, the preamble of independent claim 3, for example, clearly sets the context for the claim, thereby giving it the life, meaning, and vitality referred to by the Court in *Pitney Bowes, Inc. v. Hewlett-Packard Co.* (*Id.* at 1165-66). The preamble establishes, without question, that the rejected independent claims are directed to a method for screening financial investment opportunities in an on-line service. Claim 11 has a similar preamble reciting, "[a] system for screening financial investment opportunities". Rivette fails to teach such methods or systems, and instead indicates that the disclosed invention is designed for a customer (col. 16), where the customer is a "customer corporate entity" (col. 15, lines 50-51), that the data is that which "the customer maintains" (col. 16, line 35) for the company, and as described at col. 17, lines 17-20, the patent database 614 is the "customer's repository of patents."

From the Examiner's Answer (e.g., pages 20 – 21), it also appears that the Examiner has ignored particular claim limitations. Even though the Answer quotes MPEP §2111, referring to Applicant's opportunity to amend, and in this application Appellants did indeed amend the claims to expressly clarify that the databases were multi-company databases (see Response submitted March 15, 2007; e.g., "including data for a plurality of companies"), the Examiner has nonetheless ignored such

limitations. Hence, the financial database of Rivette is not believed to be one that includes financial data for a plurality of companies as presently set forth in the rejected claims. While Rivette refers to information about competitor companies, it does not appear to contemplate the searching of financial and intellectual property databases each having data for a plurality of companies as is presently recited in the amended independent claims, for example, independent claims 3, 11, 16 and 17.

Continuing to refer to the Examiner's Answer, in addition to ignoring limitations added by amendment to clarify independent claims 3, 11 (also claims 16 and 17), the Examiner then suggests that the limitation of multiple or plural company data in the databases is not claimed, yet concludes that Rivette discloses the claimed subject matter. With particular reference to both claims 3 and 11, the Examiner urges that the limitations argued are not claimed, yet the claims clearly recite a method for screening financial investment opportunities in an on-line service, comprising "searching a financial database, including data for a plurality of companies, for data records associated with at least one company..." (e.g., claim 3). In the noted step, searching occurs in a database including data for a plurality of companies. With respect to system claim 11, the system is for screening financial investment opportunities, and comprises "... a financial database including data records associated with a plurality of companies and an intellectual property database including data records associated with a plurality of companies" (claim 11). The limitations in claim 11 similarly make it clear that the recited databases include data records associated with a plurality of companies. Such limitations are respectfully urged to contribute to the functionality of the method/system relative to identifying investment opportunities. Absent the multi-company data, and databases to permit searching such data, it would not appear that there is much value to screen investment opportunities when information for only a single company is available for searching in the databases.

The Examiner is believed to have mis-characterized the teachings of Rivette. First, although the Examiner urges that all limitations are taught by Rivette, the Examiner still fails to identify where Rivette provides a clear teaching of a system or method for screening investment opportunities comprising both financial and intellectual property databases therein, and both databases having data for a plurality of companies - as set forth in claims 3 and 11. Apparently resorting to conjecture (e.g., "Patents are

issued to a plurality of companies." p. 22 of Examiner's Answer") the Examiner's Answer urges that data for other companies would have to be included in the intellectual property database. Rivette fails to teach the recited limitations in the context of the rejected claims (e.g., "These tools are not analysis tools."; col. 2, line 24). Accordingly, Appellants do not believe the Examiner has established where Rivette expressly teaches all the limitations as set forth in rejected claims 3 and 11. *[Note, the language cited by the Examiner in the middle of p. 23 appears to be excerpted from Col. 2, lines 29-33]* Once again, Appellants suggest that at best, this is an unsupported argument for inherency. Absent a clear teaching of the limitations set forth in the claims, as noted by the cases previously referred to, Appellants respectfully submit that all limitations of independent amended claims 3 and 11 are not taught and, therefore, cannot be anticipated by Rivette.

The Board is respectfully requested to reverse the Examiner's rejection relative to independent claims 3 and 11 as well as dependent claim 12. Appellants previously requested, in the Appeal Brief, separate consideration of dependent claims 4, 5, 6, 8-9, 13. Separate consideration is requested and Appellants have further responded to the Examiner's arguments relative to claims 4, 6, 8-9, 13, 15 and 16-17.

As for the rejection of **claim 4**, the dependent claim recites "analyzing the number of common results on a company basis to determine if the number is greater than zero, and if not relaxing the search criteria employed in at least one of the searching steps and rerunning the searches so as to obtain a non-zero number of common results." The Examiner continues to urge an overly-broad interpretation of claim 4, ignoring the specific claim limitations that relax criteria to obtain a non-zero number of common results. This might be generally characterized as broadening the search to assure that results are obtained. The Examiner apparently misunderstands the limitations of claim 4. Not only has the Examiner failed to establish where the specific limitations of claim 4 are taught by Rivette, but the discussion found at page 26 of the Examiner's answer relies on an example (not found in Rivette) and various references to col. 26 that clearly teach refining a search so as to further limit the results. This would appear to be just the opposite of the limitations of claim 4. Accordingly, Appellants respectfully maintain that claim 4 is not anticipated and requests that the Board reverse the Examiner's rejection thereof.

The Examiner's discussion of dependent **claim 6**, provides an express reference to col. 16 of Rivette. In the specific excerpts now set forth at p. 27 of the Examiner's answer, Appellants note that there does not appear to be any teaching of "... periodically launching an automated search of network resources to locate and update financial and intellectual property information..." Absent a particular teaching of the recited limitation, Appellants continue to urge that claim 6 is not anticipated and continue to request reversal of the rejection by the Board.

Relative to **claims 8 and 9**, even the newly-cited portions of Rivette (col. 11) do not appear to specifically describe constructing a search query having both financial search criteria and intellectual property search criteria as found in both claims. Accordingly, claims 8 and 9 are also urged as having been improperly rejected as anticipated by Rivette and reversal of the rejection of these claims is requested.

Claim 13, having limitations similar to claim 4 but dependent from claim 11, indicates that relaxing the search criteria is accomplished automatically. Again, the Examiner relies on references to col. 26 of Rivette as the basis for rejection and urges that Rivette's discussion of a narrowing of groups/search criteria is somehow a teaching of "automatically relaxing search criteria employed by the programmable search software so as to obtain a non-zero number of search results, as recited in the claim. The recited limitation is not directed to narrowing the search criteria. Thus, Appellants maintain that the limitations of dependent claim 13 are not anticipated, and that any rejection thereof based upon Rivette should be reversed as well.

Claim 15 (*now separately argued*), includes the limitation of "said display device is suitable for the display of at least one user-selectable data item to assist with the construction of a search query having both financial search criteria and intellectual property search criteria." The rejection urged that such limitations were taught by Rivette at col. 15, lines 5-8 (display unit) and col. 25, line 39 – col. 30, line 6 (searching module). Appellants are unable to identify just what the Examiner relies upon for teaching the claimed limitations. While col. 27, beginning at line 1, does include a detailed discussion of the search interface (e.g., FIGS. 53-57), it would appear that such searching is directed to patent information. Also disclosed is the applicability of command line query requests (e.g., cols. 29-30). However, the Examiner has failed to specifically identify where in Rivette there is disclosed a

"display device is suitable for the display of at least one user-selectable data item to assist with the construction of a search query having both financial search criteria and intellectual property search criteria." Accordingly, claim 15 is respectfully urged as novel absent the identification of a teaching of the recited limitation.

Independent claims 16 and 17 were rejected under the same bases as claims 3 and 11, and are separately argued as patentable in this Reply Brief. These claims are each directed to a "method for processing a search request" where claim 16 is a search request starting with financial search criteria and claim 17 starts with intellectual property search criteria. Once again the Examiner has apparently broadly characterized the claims as merely sending search requests and receiving results – see Examiner's Answer p. 25. Appellants respectfully contend that this is an improper characterization and fails to consider the specific limitations set forth in the claims, including other elements of the claims. At best the rejection appears incomplete in that it fails to teach all of the recited elements (e.g., distinct order that is different between claims 16 and 17) and the particular limitations, including those that were added to the claims by amendment. That the Examiner identifies teaching of software, searching module, etc. does not appear to result in a teaching of the recited method of either claim 16 or 17. Accordingly, Appellants respectfully urge that claims 16 and 17, separately, are unanticipated by Rivette.

In light of the arguments above, the Board is again respectfully urged to answer the first question in the negative and to reverse the Examiner's rejection of claims 3-6, 8, 9, 11-13 and 15-17.

Rejection Under 35 U.S.C. §103

Under section 35 U. S. C. §103, determining the propriety of a case of *prima facie* obviousness, requires ascertaining whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him (her) to make the proposed substitution, combination or other modification. As recently set forth in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007), the Supreme Court reiterated that the operative question, when considering obviousness of a combination of known elements, is

“whether the improvement is more than the predictable use of prior art elements according to their established functions” *Id.* at 82 USPQ2d 1396.

(II) Was claim 10 properly rejected under 35 USC §103(a) as being unpatentable over Rivette, with Official Notice?

As previously submitted by Appellants, *prima facie* obviousness has not been established, and the rejections have been respectfully traversed. Moreover, although Appellants have addressed the various rejections, the following discussion sets forth the bases upon which the rejections are traversed.

(a) whether the rejection properly establishes *prima facie* obviousness and provided some articulated reasoning and some rational underpinning to support the legal conclusion of obviousness;

The distinctions over Rivette are generally set forth above relative to claim 3, from which claim 10 indirectly depends, and claim 4, from which claim 10 directly depends. Furthermore, Appellants separately urge that the rejection of claim 10 is improper and that *prima facie* obviousness has not been established. Accordingly, the Board is respectfully requested to reverse the rejection of dependent claim 10.

Appellants previously urged that the Examiner had not established *prima facie* obviousness as no teaching was identified as suggesting “accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis” as recited in claim 10. The Examiner acknowledged that Rivette did not teach such a step, but continues to urge Official Notice thereof.

(b) whether the rejection under 35 USC §103(a) improperly relies upon information that has not been established as having been available prior to Appellants’ application; and

In response to Appellants’ traverse of the Official Notice, for the first time in the Final Office Action which is appealed from, the Examiner produced what is alleged to be “documentary evidence” to support a position that “it is old and well-known that publicly available financial and intellectual property data concerns assignee and ticker data.” The Examiner apparently recites the same “documentary evidence” in the Examiner’s Answer. Appellants again traverse the Official Notice as not having

been demonstrated by adequate "documentary evidence" where the "documents" provided are search results for an on-line search apparently conducted by the Examiner in April 2007 (well after Appellants' filing date of Sept. 27, 2001) for alleged news articles with one or more of various words such as ticker, assignee, etc. Furthermore, none of the articles identified in the search results has been made of reference in the instant application or provided in support of the "Official Notice." One is, therefore, left to wonder whether such documents might not support Official Notice, or may even teach away from that which they are alleged to support.

(c) whether the rejection under 35 USC §103(a) omits elements recited in the rejected claims.

The "documents" alleged in support of the Official Notice, including the discussion at p. 30 of the Examiner's Answer, do not specifically teach the recited claim limitation (claim 10) that requires "accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis." Absent a specific article(s) Appellants only have 40+ pages of Google-generated search results and computer-generated summaries highlighting keywords searched. Such "documentation" does not meet the burden of proving a basis for the Examiner's Official Notice. Accordingly Appellants continue to traverse the Official Notice and/or the Examiner's "documentary evidence" as insufficient to establish any teaching or suggestion of the limitations expressly set forth in claim 10. Absent a teaching of accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis, *prima facie* obviousness has not been established. Claim 10 is, therefore, urged to be patentable over Rivette and the Board is respectfully requested to reverse the rejection thereof.

(III) Whether claims 1, 2, 7 and 14 were properly rejected under 35 USC §103(a) as being unpatentable over Rivette in view of Black?

As Appellants urged previously, *prima facie* obviousness has not been established, and the rejections of claims 1, 2, 7 and 14 have been traversed.

(a) whether the rejection properly establishes *prima facie* obviousness and provided some articulated reasoning and some rational underpinning to support the legal conclusion of obviousness;

As for amended claim 1, the distinctions over Rivette are generally characterized above relative to similar independent claims. Appellants respectfully submit that the additional limitations that the databases include data for a plurality of companies are not taught or suggested by Rivette or Black. In the Response to Arguments, the Examiner indicated that the amendment to the preamble has not been given patentable weight even though the preamble characterizes the on-line financial service screening method. Appellants respectfully submit that the limitation as to the recited database is not a limitation as to purpose or intended use. Rather, the limitation is directed to the structure of the claimed invention (further defining the database) such that "when read in the context of the entire claim, recites limitations of the claim, [and] ... should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999) (*emphasis added*).

(b) whether the rejection under 35 USC §103(a) omits elements recited in the rejected claims.

In spite of Appellants prior requests and arguments in the Appeal Brief, the Examiner's Answer still fails to indicate with any specificity where the limitation of "relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one" is disclosed between columns 25 and 30 of Rivette (Examiner's Answer, p. 14). Appellants remain unable to identify just what the Examiner relied upon for teaching such a limitation, and respectfully suggest that the Examiner has failed to establish *prima facie* obviousness by failing to identify support for the alleged teaching (as noted above, the prior art reference or combination must teach or suggest all the claim limitations). Hence, Appellants continue to traverse the rejection of independent claim 1, and claim 2 dependent therefrom, and respectfully request the Board to reverse the rejection thereof.

As to the rejection of dependent **claims 7 and 14**, Appellants continue their traversal of the rejection and respectfully urge the Board to overturn the rejection of dependent claims 7 and 14 for reasons previously set forth in the Appeal Brief.

Conclusion

As set forth in the Appeal Brief and as further indicated in the arguments presented herein, claims 3-6, 8, 9, 11-13 and 15-17 were improperly rejected under 35 USC §102(e) as being anticipated by Rivette as the rejection failed to establish anticipation of each and every element recited in the rejected claims. Claim 10 was improperly rejected under 35 USC §103(a) as being unpatentable over Rivette with Official Notice as the rejection failed to establish or properly document the support for such notice. Furthermore, claims 1, 2, 7 and 14 were also improperly rejected under 35 USC §103(a) as being unpatentable over Rivette in view of Black.

In light of the supplemental arguments set forth above in response to the Examiner's Answer, Appellants respectfully continue to urge that all of the questions presented should be answered in the negative, that all rejections set forth should be reversed, and that Appellants' pending claims should be indicated as allowable.

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